THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte MANFRED FUERSICH, HELMUT TREIBER
and WOLFGANG ZAHN

_____

Appeal No. 1997-4093
Application No. 08/115,209[1]

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Before HAIRSTON, JERRY SMITH, and FRAHM, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 6 and 10.

[1] Application for patent filed September 1, 1993.

The disclosed invention relates to a method for determining the amount of light in each primary color for copying colored originals on different types of film that appear at a copying station to be copied.

Claim 1 is the only independent claim on appeal, and it reads as follows:

1. In a photographic copying process in which colored originals on different types of film appear at a copying station to be copied, a method for determining the amount of light in each primary color for copying such colored originals, the color image of each original being scanned to determine the density of the primary colors by region or by point and the results of such density determination being used to control the amounts of the copying light, wherein for each scanned region a first difference is formed between the density values of two primary colors and a second difference is formed between the density values of one of these primary colors and the third primary color and the average density is formed from the density measurements of the three primary colors, such that for each film to be copied a color density difference curve relative to average density is produced, which curve describes the color behavior of the film which contains the original to be copied and supplies film-specific values for producing copies of the film, said film-specific values being used for the determination of the copying light illumination for the colored original to be copied, the improvement comprising forming color density difference curves relative to average density for films of a specific type, storing said last named color density difference curves, and, when a film of said specific type appears at the copying station containing a colored original to be copied, using these stored color density difference curves to determine the amount of light in each primary color for copying said colored original.

The references relied on by the examiner are:

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| Thurm et al. (Thurm) | 4,279,502 | July 21, 1981 |
| Fursich et al. (Fursich) | 4,561,768 | Dec. 31, 1985 |
| Terashita | 5,148,213 | Sept. 15, 1992 |

Claims 1 through 6 and 10 stand rejected under the second paragraph of 35 U.S.C. § 112 because the phrase "said last named color density difference curves" lacks antecedent basis.

Claims 1 through 6 and 10 stand rejected under the first paragraph of 35 U.S.C. § 112 because the improvement portion of Jepson-type claim 1 is not adequately described or enabled.

Claims 1 through 6 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art of the preamble of Jepson-type claim 1 (as represented by Fursich and Thurm) in view of Terashita.

Reference is made to the final rejection (paper number 18), the briefs (paper numbers 20 and 23), and the answer (paper number 21) for the respective positions of the appellants and the examiner.

## OPINION

The rejections of claims 1 through 6 and 10 under the first and second paragraphs of 35 U.S.C. § 112 are reversed. The rejection of claims 1 through 6 and 10 under 35 U.S.C. § 103 is sustained as to claims 1 through 3 and 10, and is reversed as to claims 4 through 6.

Turning first as we must to the indefiniteness rejection of claims 1 through 6 and 10, this rejection is reversed because it is patently clear from claim 1 that the "last named color density difference curves" are the preceding "color density difference curves" that immediately follow the phrase "the improvement comprising."

Turning next to the lack of enablement rejection of claims 1 through 6 and 10, we find that the examiner has not satisfied the initial burden of setting forth a reasonable basis for questioning the enablement of the disclosed and claimed invention[2]. For example, the examiner has never explained why formulae, algorithms, and flowcharts are needed in light of the explanation of color density difference curves in the admitted prior art to Fursich and Thurm. Even if such

[2] See In re Doyle, 482 F.2d 1385, 1392, 179 USPQ 227, 232 (CCPA 1973).

a basis had been established, the appellants have adequately demonstrated that the disclosed and claimed invention would have been adequately enabled by the admitted prior art. Accordingly, the lack of enablement rejection of claims 1 through 6 and 10 is reversed.

Turning lastly to the prior art rejection of claims 1 through 6 and 10, the examiner is of the opinion that it would have been obvious to one of ordinary skill in the art to store the noted prior art color density information of the preamble (and correspondingly of the references to Fursich and Thurm) for films of specific types for future use so that "printing may be carried out with high processing capabilities" (final rejection, pages 5 through 7).

Appellants have acknowledged (Brief, page 9) that:

> The apparatus and method for forming color density difference curves is fully described in the prior art Thurm et al. and Fursich et al. references. Indeed, the drawing in this case is the same as one of the drawings in the Fursich et al. patent . . . . The conventional features of this application are illustrated in the drawing in the form of labeled rectangular boxes 5, 6, 7, 8 and 9.

Appellants go on to state (Brief, page 11) that "[t]he specification of this application expressly identified Thurm

et al. and Fursich et al. as patents which teach acceptable ways of forming color density difference curves," and that "[t]he process for generating the standard curves involves the use of the Fursich et al. apparatus in combination with a test film having three gray fields of known density as described in the first two full paragraphs on page 8 of the specification." Appellants have likewise acknowledged (Brief, page 12) that "[i]ndeed, even if the formation of color density difference curves was not described in the prior art, a person of ordinary skill in the photographic arts would surely have been able to measure red, green and blue densities of a film and then chart density difference curves (blue minus green and red minus green versus average density)."

Appellants argue (Brief, page 16) that "[t]he prior art does not teach the formation of *standard* color density difference curves, i.e. color density difference curves *specific to film type*," and that "obviousness under 35 U.S.C. § 103 requires a showing that the prior art provides some suggestion or motivation to combine the known steps."

We agree with appellants (Brief, page 15) that Terashita is not concerned with color density difference curves. As indicated supra, the admitted prior art, Fursich and Thurm are relied on by the examiner for teachings of color density difference curves. We likewise agree with appellants (Brief, page 15) that Terashita teaches that "[a] DX code on the film is used to store data on the film type." On the other hand, Terashita teaches that the stored data is used in the future to "reduce the time for storing data, and hence printing can be effected with high processing capabilities" (column 4, lines 34 through 37). In accordance with the teachings of Terashita, "it is possible to automatically store necessary data with respect to new film types" (column 4, lines 45 through 51).

For the advantage of automatically storing necessary data for new film types to thereby enhance processing capabilities, we are of the opinion that it would have been manifestly obvious to the skilled artisan to store the well-known color density curves of the admitted prior art for different types of film. Although Fursich avoids the need for such stored data concerning different film types (column 7, lines 37

through 43) (Brief, pages 16 and 17), Terashita clearly counsels against clearing memory of such film data because it can be used again in the future, and time can be saved if the film data does not have to be generated a second time.

In summary, the obviousness rejection of claims 1 and 2 is sustained. The obviousness rejection of claim 3 is sustained because appellants have chosen to let this claim fall with claim 2 (Brief, page 6). The obviousness rejection of claim 10 is sustained because a mere statement by appellants (Brief, page 18) describing what is set forth in the claim is not an argument for patentability of the claim. The obviousness rejection of claims 4 through 6 is reversed, however, because we agree with the appellants (Brief, page 18) that the examiner has not demonstrated the obviousness of these claims.

## DECISION

The decision of the examiner rejecting claims 1 through 6 and 10 under the first and second paragraphs of 35 U.S.C. § 112 is reversed. The decision of the examiner rejecting claims 1 through 6 and 10 under 35 U.S.C. § 103 is affirmed as

to claims 1 through 3 and 10, and is reversed as to claims 4 through 6. Accordingly, the decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

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|---|---|---|
| KENNETH W. HAIRSTON<br>Administrative Patent Judge | ) | |
| JERRY SMITH<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |
| ERIC FRAHM<br>Administrative Patent Judge | ) | |

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Appeal No. 1997-4093
Application No. 08/115,209

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Appeal No. 1997-4093
Application No. 08/115209

APJ HAIRSTON

APJ JERRY SMITH

APJ FRAHM

DECISION: AFFIRMED-IN-PART
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No

Index Sheet-2901 Rejection(s):
Prepared: February 1, 2001

Draft Final

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OB/HD GAU

PALM/ACTS 2/BOOK
DISK(FOIA)/REPORT